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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,126	08/23/1999	GEROLD MAHLER	F-6224	2441

7590

04/10/2003

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EXAMINER

MCKANE, ELIZABETH L

ART UNIT

PAPER NUMBER

1744

14

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/319,126	Applicant(s) MAHLER ET AL.	
	Examiner Leigh McKane	Art Unit 1744	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10, 16-19 and 23-26 is/are allowed.
- 6) ☒ Claim(s) 3-5, 11, 13-15, 20-22, 27, 29, 31, and 33 is/are rejected.
- 7) ☒ Claim(s) 12, 28, 30, 32 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. The amendment after final rejection filed on April 2, 2003 has been entered.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11, 27, 29, 31, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the above claims contain the phrase "the hose ends are laid showing to opposing sides of the space inside the cover" which renders the claims vague and indefinite as the Examiner cannot determine what exactly is meant by this phrase. The specification provides no teaching or clarification as to the meaning of this phrase.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 4 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase et al (U.S. Patent No. 3,431,061).

Chase et al teaches a method of preserving wood wherein the wood is sealed within a Casing, thereby allowing the naturally occurring microorganisms to consume the remaining oxygen. Chase et al discloses that the level of oxygen is maintained at a value below about 0.5% after one to three days. See Abstract; col.1, lines 35-45; col.1, line 59-col.2, line 4; col.2, lines 23-30. The examiner submits that since the method of Chase et al is identical to that of the present invention, the oxygen and carbon dioxide levels would inherently reach the claimed levels since no oxygen is introduced into the sealed packages of wood.

The packaging material of Chase et al is disclosed to be flexible layers of thermoplastic material or scrap papermaker's felt which is made impermeable to oxygen. See col.2, lines 16-22. The sealed package may be protected with multiple layers of asphalt impregnated felt. See col.2, lines 37-43. This material is inherently impermeable to light. Furthermore, some of the thermoplastic materials employed by Chase et al are also inherently impermeable to light.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al.

Although Chase et al does not disclose minimizing the amount of air within the package before sealing, the reference does recognize that the microorganisms do not promote decay of the wood once the oxygen is consumed. Thus, it would have been obvious to one of ordinary skill in the art to minimize the amount of available oxygen in order to expedite the consumption of oxygen.

9. Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al in view of Wadas, Jr. (U.S. Patent No. 5,718,851)

As to claim 5, Chase et al teaches a variety of thermoplastic materials can be used as the cover but does not disclose if they are UV-resistant. See col.2, lines 16-22. Wadas, Jr. discloses a method of protecting wood wherein the wood is covered with a UV-resistant material (col.2, lines 49-52). Since Wadas, Jr. teaches that wood is susceptible to direct sun exposure, it would have been obvious to use a UV-resistant material in the cover of Chase et al.

With respect to claims 7, 8, 20 and 21, Chase et al discloses that several layers of material may be used to cover the wood, wherein the layers are "suitably sealed." See col.2, lines 23-30. The Examiner submits that one of ordinary skill in the art would have been apprised of "suitable" sealing means, such as welding and bonding.

As to claims 9 and 22, Chase et al teaches that "several plies of flexible plastic sheet material may be used, or several plies of asphalt impregnated felt may be used. These multiple plies may be all of one material or of composite material and are readily adhered to each other by heat-sealing, mechanical clamping, or adhesive..." (col.2, lines 53-58).

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10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al in view of Seidner (U.S. Patent No. 5,447,686).

Chase et al does not teach using a rigid container of hold as the storage means. Seidner et al discloses that it is known in the art to employ a ship's hold as a location for wood preserving. Since a hold allows for wood treatment during transit, it would have been obvious location for treating wood in the method of Chase et al.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase et al and Seidner as applied to claim 13 above, and further in view of Reeves et al (U.S. Patent No. 5,725,613).

The combination of Chase et al with Seidner fails to disclose using recovered exhaust gases in the treatment process. However, Reeves et al teaches that it was known in the art at the time of the invention to treat bulk material with recovered carbon dioxide. See col.7, lines 29-35. It would have been obvious to do so in the combination for economical use of carbon dioxide.

### *Claim Objections*

12. Claims 9 and 22 are objected to because of the following informalities: the term "damping device" should be changed to --clamping device--. Appropriate correction is required.

13. The Declaration under 37 CFR 1.132 filed 26 March 2003 is insufficient to overcome the rejection of claims 3-5, 13-15, and 20-22 based upon Chase et al as set forth in the last Office action because: the statements found in the Declaration amount to merely opinions and are not

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supported by any factual evidence. A statement of “the “cocoon” of Chase et al. is not absolutely air-tight” is merely conjecture where it is unsupported by data or test results.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Allowable Subject Matter***

14. Claims 6-10, 16-19, and 23-26 are allowed.
15. Claims 11, 12, and 27-34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Response to Arguments***

16. Applicant's arguments filed April 2, 2003 have been fully considered but they are not persuasive.
17. Applicant argues that because “of the different materials for the bottom sheet and the covering sheet, effective welding of the different materials with heat-welding equipment is precluded.” However, using different materials for the bottom and covering sheet is only one embodiment of the invention. In col.2, lines 59-65, Chase et al discloses that polyethylene can be heat sealed to form a “cocoon” around the wood. Alternatively, an asphalt based adhesive may be used to seal the seams of asphalt impregnated felt.

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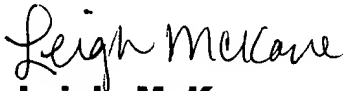
Moreover, although Applicant argues that the "cocoon" of Chase et al "is not absolutely air-tight", no evidence has been submitted to support this allegation. As such, the Examiner must maintain that as Chase et al specifically teaches using materials that are impermeable to oxygen and teaches sealing the materials to form a "cocoon", the cocoon must be air-tight.

*Conclusion*

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 703-305-3387. The examiner can normally be reached on Monday-Wednesday (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7719 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
**Leigh McKane**  
**Primary Examiner**  
**Art Unit 1744**

elm  
April 9, 2003